

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of M. Obukowicz et al. Art Unit 1651
Serial No. 10/022,862
Filed December 13, 2001
Confirmation No. 4101
For SELECTIVE COX-2 INHIBITION FROM PLANT EXTRACTS
Examiner M. Meller

August 14, 2002

RESPONSE TO RESTRICTION REQUIREMENT

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action mailed on July 30, 2002, in which an election of a single disclosed species for prosecution on the merits was requested.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made **without serious burden**, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."¹

In this case, restriction is not proper. Claims 1-112 are currently pending. These claims are **all** generally directed toward organic extracts isolated from various plants that selectively inhibit the enzyme COX-2. Any search of the prior art and examination involving such an extract from one plant species, therefore, will necessarily co-extend with the search and examination of plants belonging to other species. Further, the prior art regarding plant extracts that selectively inhibit COX-2 is sufficiently sparse to allow the examination of all these claims without undue burden. Thus, as the examination of the entire application may be made without serious burden, claims

¹ MPEP § 803 (emphasis added).

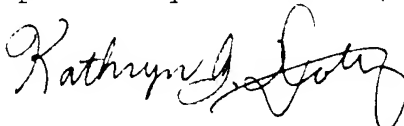
1-112 should be examined in accordance with MPEP § 803 without an election of species.

Applicants, subject to the foregoing traverse, hereby elect the plant of the genus *Capsicum* and of the species *frutescens* for prosecution on the merits. Moreover, for the disease applicants elect arthritis. Claims 1-3, 58, 60, and 97-105 read on the elected species.

According to M.P.E.P. §809.02(c), an examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species and according to M.P.E.P. §809.02(e), whenever a generic claim is found to be allowable in substance, action on the species claims shall thereupon be given as if the generic claim were allowed. Thus, if it is determined that the elected species is patentable, it is incumbent upon the Office to search additional species that fall within any allowable generic claims.

Applicants reserve the right to file divisional applications directed to the subject matter of the non-elected claims.

Respectfully submitted,



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